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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,440	03/12/2004	Marc Shepard	MSFT122465	6241
38991 7590 09/12/2007 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347			EXAMINER VY, HUNG T	
			ART UNIT 2163	PAPER NUMBER
			MAIL DATE 09/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,440

Applicant(s)

SHEPARD ET AL.

Examiner

Hung T. Vy

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. As of entry of the amendment filed on 05/21/2007 and the RCE filed on 06/20/2007, claims 1-25 are pending in this application. Upon reconsideration, Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 14 are rejected under 35 U.S.C 101 because the claimed inventions are directed to non-statutory subject matter.

With respect to claims 1 and 14, the claim is rejected under 35 U.S.C. 101 because the invention, as claimed, appears to be directed to merely an abstract idea. The Examiner makes this assertion because the claim simply recites tag-based data structure to a client computer, metadata corresponding to a software update available for installation on the client computer, a tag-based identifier element that uniquely identifies the software update, and one addition element of the tag-based element with no attempt to tie all of the methods steps together in order to carry out a final, conclusionary method step.

Since the claim presented by the applicant is simply a representation of an abstract idea, the claims are not covered by the statutory categories of patentable subject matter set forth in 35 U.S.C. 101.

However, an abstract idea is categorized as one of three judicially created exceptions to patentable subject matter (the three exceptions are Laws of Nature, Natural Phenomena, and Abstract Ideas). The courts have concluded that in order to patent one of the three judicial exceptions to the statutory categories of invention the applicant must show that the claimed invention has a practical, real-world application that produces a useful, concrete, and tangible result (State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02).

In order to overcome this rejection, it is required that the Applicant amend claim 1 such that claims 1 and 14 provides a final, conclusionary step. This final step should tie together all previously recited method steps. Finally, the claimed invention as a whole must set forth a practical application of the invention, which provides a user, concrete, and tangible result. Correction of this deficiency is required.

With respect to claims 2-13 and 15-25, claims 2-13 and 15-25 are rejected with 35 U.S. C. 101 because it fails to resolve the deficiencies of claims 1 and 14.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 recites the limitation "the above-described order" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-6, and 16-18 are rejected under 35 U. S. C. § 102 (e) as being anticipated by Rabin et al. (U.S. patent No. 6,697,948).

Regarding claims 1 and 14, Rabin et al. discloses a method for communicating update metadata (*examiner asserts that "metadata" is data about data so "software update" is metadata*)) corresponding to a software update to a client computer, (i.e., "user devices"(104-107)(fig. 1)) comprising: providing a computer-readable medium storing computer readable data organized in a tag-based data structure to a client computer (i.e., "tag server accepting the instances of software" (col. 3, line 50-55)), wherein the tag-based data structure includes tag-based elements storing metadata corresponding to a software update available (i.e., "determine of use policy of the tag associated with the instance of software and updates tag information in the user device" (col. 24, line 39-50)) for installation on the client compute (*Examiner asserts that based on dictionary that "metadata" is data about data such as software update*), the tag-based data structure comprising: a tag-based identifier element that uniquely identifies the

software update (i.e., "each tag uniquely identifies an instance of software with which it is associated"(col. 3, line 50-55)); and at least one additional element of the following tag-based elements: a localized property element for storing language specific information directed to a computer user relating to the software update (i.e., "produces at least one instance of software incorporating a device identifier inside a test. The test will be an "if statement" in a typical programming language" (col. 16, line 34-49)), and additional, Rabin et al. discloses extra, a rule element storing rules for determine the applicability of the software update to client computer (i.e., "a guardian center having a tagged software database and a verification program...to ensure that the tags are in compliance with at least one usage supervision policy. Preferably, the usage supervision publicity is associated with at least one individual instance of software with which at least one tag is associated" (col. 5, line 10-25) or "Policies and rules prescribed by software vendor other organization" (col. 29, line 29-35) or (col. 19, line 49-56)), a file element identifying software update's payload and information to the software update's payload (i.e., "enable vendors of software to charge on a pay per-use basic for an instance of software" (col. 2, line 55-60) or (col. 13, line 60-67 and col. 14, line 1-5) or (col. 18, line 55-60)), and a property element storing general properties relating to the software update including update handler information identifying an update handler for installing the identified software update on the client computer (col. 2, line 45-67 and col. 3, line 1-12) and fig. 2) (Examiner asserts that only one additional element is need for required for the claimed invention).

Regarding claim 3, best understood, Rabin et al. discloses wherein the tag-based elements in the tag-based data structure are arranged in the tag-based data structure according to the above-described order (i.e., "each tag uniquely identifies an instance of software with which it is associated"(col. 3, line 50-55) and, "a guardian center having a tagged software database and a verification program...to ensure that the tags are in compliance with at least one usage supervision policy.

Preferably, the usage supervision publicity is associated with at least one individual instance of software with which at least one tag is associated" (col. 5, line 10-25) and Examiner asserts that at fig. 2 shows the order to communicating update metadata corresponding to a software update to user device (104) such as requests for tags, a rule element (profile of tags)).

Regarding claims 4 and 16, Rabin et al. discloses wherein identifies element includes a unique identifier that uniquely identifies the software update, and revision number associated with the software update (*i.e., e., "each tag uniquely identifies an instance of software with which it is associated"(col. 3, line 50-55) and "a table of file stored in a device containing information related to tags associated with instances of software as well as information relating to the user or usage supervision of software instances on that device" (col. 30, line 9-15)).*

Regarding claims 5 and 17, Rabin et al. discloses the relationship element includes prerequisite information that identifies another software update that much installed before the identifier software update is installed (*i.e., each tag uniquely identifies that instance of software to which it is associated and each tag includes encodes information concerning the name of the instance of software associated the tag, and hashing value computed on the instance of software associated with the tag" (col., 17, line 34-42) or "verify hash function values in the tag and the signature in the tag" (col. 24, line 25-35) and Examiner asserts that based on the hash value, that identifies another software update that much install before or later depend on hash value which equivalent with claimed invention).*

Regarding claims 6 and 18, Rabin et al. discloses wherein the relationship element further includes information identifying a plurality of software updates joined together with Boolean operator into a logical statement, such that the evaluation of the logical statement determines the suitability of the identified software update for installation on the client computer (*i.e., "a hash function values on the instance of software and compares*

the computed value with a hash function value in the tag to determine" (col. 8, line 26-35)).

Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 15 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rabin et al. (U.S. patent No. 6,697,948 in view of Lau (U.S. Pub. No. 2003/0204481).

With respect to claims 2 and 15, Rabin et al. discloses all limitations recited in claim 1 and 15 except the tag-based data structure is an XML data structure. However, Lau discloses the tag-based data structure is an XML data structure (*i.e.*, "XML source code containing tags, elements, attributes, etc...automatic updating of the XML source code by the software 46" (0040)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rabin et al.'s invention by having the tag-based data structure is in XML data structure in order to improved visualization and construction technique of an XML schema model, as well as a method and system for visually constructing XML schemas which can be used to efficiently and logically represent XML schemas for the stated purpose has been well known in the art as evidenced by the teaching of Lau (Lau, 0007).

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7. Claims 7-8, 10, 19-20, and 22 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rabin et al. (U.S. patent No. 6,697,948 in view of Fox et al. (U.S. Pub. No. 2003/0018964).

With respect to claims 7-8 and 19-20, Rabin et al. discloses all limitations recited in claim 3 and 14 except the plurality of software updates are jointed together with Boolean operator into a logical statement, such the evaluation of the logical statement determines the suitability of the bundled software updates for installation on a client computer. However, Fox et al. discloses the plurality of software updates are jointed together with Boolean operator into a logical statement, such the evaluation of the logical statement determines the suitability of the bundled software updates for installation on a client computer (*i.e.*, "*leading to problem is delivering bundle description along with the corresponding software bundle*" (0012 and 0066)). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rabin et al.'s invention by adding the code for relationship for bundle information and the code for information of relationship element of a plurality software update that must be installed bundle in order to have facilitate sufficient and effective update of firmware and/or software packages in update or distribution environment for the stated purpose has been well known in the art as evidenced by the teaching of Fox et al (Fox et al., 0013-14).

With respect to claims 10 and 22, Fox et al. discloses wherein the relationship element includes prerequisite information (*i.e.*, "*there may also be a number of prerequisites*" (0010, 0053)) (with motivation on claim 7-8 and 19-20).

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8. Claims 9 and 21 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rabin et al. (U.S. patent No. 6,697,948 in view of Cheah et al. (U.S. Pub. No. 2004/0015939).

With respect to claims 9 and 21, Rabin et al. discloses all limitations recited in claim 3 and 14 except supersedence information that identifies at least one other software update that is superseded by the identified software update. However, Cheah et al. discloses supersedence information that identifies at least one other software update that is superseded by the identified software update (i.e., "updated version of the software" module that was created after extensive testing of the device) and, therefore, supercedes the version of the data that is in the mask ROM 1" (0020)). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rabin et al.'s invention by adding the code for relationship for supercedence information in order to have facilitate efficient and effective update of firmware and/or software packages in update or distribution environment with time saving for the stated purpose has been well known in the art as evidenced by the teaching of Cheah et al (Fox et al., 0005).

9. Claims 11-13 and 23-25 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rabin et al. (U.S. patent No. 6,697,948 in view of Moshir et al. (U.S. Pub. No. 2002/0100036).

With respect to claims 11 and 23, Rabin et al. discloses all limitations recited in claim 3 and 14 except patching existing files on a client computer. However, Moshir et al. discloses patching existing files on a client computer (i.e., "If a problem is discovered in an existing piece of software, then a fix or patch can be installed" (0053)). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to modify Rabin et al.'s invention by adding the code for patching existing files on a client computer in order to have different way to update the software to reduce demands on human administrator for the stated purpose has been well known in the art as evidenced by the teaching of Moshir et al (Moshir et al., 0019).

10. With respect to claims 12-13 and 24-25, Moshir et al. discloses wherein replacing existing files on client computer (*i.e.*, "*replacing*" the software" (0053)) (with motivation on claim 11 and 23)

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Hung Vy', with a long horizontal line extending to the right.

September 04 2007

Hung Vy

Patent Examiner.